

Appl. Serial No. 09/527,717
Docket No.: USBA.004PA
Office Action Response and Amendment

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The Office Action dated April 9, 2003, indicated that claims 1-13 and 16-22 stand provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 4-28 of copending Application No. 09/310,711 (USBA.005PA); claims 1-15 stand rejected under §102(b) as being anticipated by *Ginter et al.* (U.S. Pat. No. 6,029,150). Please note, however, that U.S. Pat. No. 6,029,150 is not issued to *Ginter et al.* but instead to *Kravitz*, as discussed further below.

New claims 23-27 manifest Applicant's "long-accepted right to press alternative claims covering different aspects of ... [Applicant's disclosed] invention." *Amgen, Inc. v. Hoechst Marion Roussel*, 126 F. Supp.2d 69 (D. Mass. 2001). Support for the new claims can be found in connection with many of the figures and in the discussion thereof. For example, support is provided in connection with the discussion (and illustration) of Figure 1.

Applicant respectfully traverses the provisional double patenting rejection of claims 1-13 and 16-22 because claims 4-25 of copending U.S. Patent Application Serial No. 09/310,711 (USBA.005PA) have been canceled and the remaining claims (26-28) referred to in the Office Action and the rejected claims are not directed to identical subject matter. The cancellation of claims 4-25 was effected by way of a Preliminary Amendment of the 09/310,711 application on January 30, 2003. Therefore, the rejection relevant to canceled claims 4-25 is moot. Applicant fails to recognize how the subject matter of claims 26-28 of the 09/310,711 application might be considered identical to the subject matter of the rejected claims 1-13 and 16-22, and no explanation of such correspondence has been provided. Therefore, the remaining claims 26-28 of the 09/310,711 application do not meet the requirements for establishing a statutory double patenting rejection, which dictate that the subject matter of the copending claims be identical.

Applicant also respectfully traverses the provisional double patenting rejection of claims 14-15 because claims 26-27 of copending U.S. Patent Application Serial No.

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09/259,657 have been canceled. The cancellation of claims 26-27 was effected by way of an Amendment of the 09/259,657 application on January 10, 2003. Therefore, the rejection relevant to canceled claims 26-27 is moot.

Applicant further respectfully traverses both above-noted provisional double patenting rejections and, in view of the co-pendency of these cases, requests that each said rejection be withdrawn. Pursuant to the guidelines set forth in the MPEP, because there should be no other rejections present after entering this Office Action Response, maintaining these provisional double patenting rejections would be improper. As stated in the MPEP § 804:

I. INSTANCES WHERE DOUBLE PATENTING ISSUE CAN BE RAISED

A. ***

B. Between Copending Applications-Provisional Rejections

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

If the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

Accordingly, Applicant submits that the Examiner should withdraw these provisional rejections and permit this instant Application to issue as a patent.

Turning now to the Section 102(b) rejection, Applicant respectfully traverses as this rejection does not properly identify which patent reference is being relied upon for

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asserting the rejection. The Office Action indicates that claims 1-15 stand rejected under §102(b) as being anticipated by U.S. Pat. No. 6,029,150 -- issuing in the name of *Ginter et al.* However, U.S. Pat. No. 6,029,150 did not issue in the name of *Ginter et al.* but rather in the name of *Kravitz*. Therefore, the relied-upon U.S. Patent is ambiguously identified (by an inventor's name and by a contradicting U.S. Patent No.).

To the extent that the Examiner is referring to U.S. Patent No. 5,982,891 to *Ginter et al.* in making the Section 102(b) rejection (Form PTO-892 cites U.S. Patent No. 5,982,891 -- issuing in the name of *Ginter et al.*), Applicant traverses the rejection because the Office Action fails to cite a portion of the '891 reference that completely corresponds to the claimed limitations. For example, regarding the rejection of claims 1, 3, 5, 9 and 13, the cited portions of column 54 and column 121 of the '891 reference do not appear to teach or suggest a transaction validation system for auditing transactions, with user profiles, in the context of the present invention. Specifically, the cited portion of column 54 of the '891 reference is directed to a transaction involving goods that are in the form of electronic content, with users (or consumers) having access to the content being defined by "rules and controls." There appears to be no mention of such "rules and controls" (terminology as used in the Office Action) for "authorized users empowered to authorize payment by the vendor ..." (e.g., Applicant's claim 1); rather, the "rules and controls" are directed to controlling consumer access to data and not for auditing a transaction. Further, Applicant fails to see where the '891 reference teaches corresponds to the claim limitations directed to using profile list criterion to generate information for auditing a transaction, or the generation of auditing information in any manner. These aspects of Applicant's invention are present in each pending independent claim. Therefore, Applicant submits that the rejection is improper and requests that any such §102(b) rejection in view of U.S. Patent No. 5,982,891 to *Ginter et al.* be withdrawn.

To the extent that the Examiner is referring to U.S. Patent No. 5,982,891 to *Ginter et al.* in making the Section 102(b) rejection, Applicant would also request a more particular explanation of correspondence between the relied-upon teachings and the limitations of the rejected claims.

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In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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